

REMARKS

In response to the Office Action dated July 29, 2004, the Applicant has amended independent claims 1, 6, 13, 15, 23, 28, 36, 40 and 46. Claims 1-48 remain in the case. Reexamination and reconsideration of the application, as amended, are requested.

Claims 1-8, 10-20, 23-34, 36-42 and 44-48 were rejected under 35 U.S.C. § 102(b) as being anticipated by Stumm (U.S. Patent No. 5,768,528). Also, claims 9, 21-22, 35 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stumm (U.S. Patent No. 5,768,528) in view of Milovanovic et al. (U.S. Patent No. 6,484,198).

The Applicants respectfully traverse these rejections based on the amendments to the claims and the arguments below.

With regard to the rejections under U.S.C. 102, the Applicants respectfully submit that Stumm et al. do not disclose, teach, or suggest all of the claimed features. Namely, the Applicants' invention includes a delivery rule received from the user or subscriber for the content. The user or subscriber creates and controls a custom issue delivery schedule.

In contrast, Stumm et al. disclose that "...each publisher is allowed to control the times which a subscriber is scheduled to access server system 20." This is the opposite of the Applicants' claimed invention, which allows the subscriber, and not the publisher, to control delivery times and schedules. Although the Examiner stated that Stumm et al. disclose that the "...subscriber control time which a subscriber is scheduled to access server system..." for the content (see page 5, argument No. 15 of the Office Action), this statement by the Examiner is incorrect. Instead, the Stumm et al. reference explicitly states the opposite of the Examiner's statement. In particular, Stumm et al. explicitly state that "[T]hus, each publisher is allowed to control the times which a subscriber is scheduled to access server system 20." (see col. 9, lines 20-27 and lines 45-51), which is a teaching away from the Applicants' claimed invention.

As such, allowing a subscriber to create and control custom delivery schedules would contradict the statement made in col. 9, lines 20-27 and lines 45-51 of Stumm et al. Hence, this element of the Applicants' claimed invention would destroy the main function, purpose and spirit of Stumm et al. As such, this "teaching away" prevents this

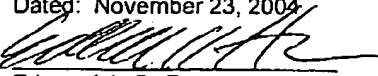
reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Therefore, since the claimed elements of a delivery rule received from the user or subscriber for the content and enabling the subscriber to create and control a custom issue delivery schedule are not disclosed by Stumm et al. and because Stumm et al., teaches away from the Applicants' invention, Stumm et al. cannot anticipate the claims, and hence, the Applicants submit that the rejection should be withdrawn.

With regard to the rejection under U.S.C. 103(a) of the rest of the claims, as argued above, the Applicants submit that the Stumm et al. reference, alone or in combination with the Milovanovic et al. do not disclose, teach, or suggest the Applicants' delivery rule received from the user or subscriber for the content and enabling the subscriber to create and control a custom issue delivery schedule. This **failure** of the references, either alone or in combination, to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

With regard to the rejection of the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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